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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/811,987	03/19/2001	Bernd Bruchmann	12075	9596

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BASF CORPORATION
LEGAL DEPARTMENT
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EXAMINER

SERGEANT, RABON A

ART UNIT	PAPER NUMBER
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1711

12

DATE MAILED: 04/15/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.
09/811,987

Applicant(s)
Bruchmann et al.

Examiner
Rabon Sergeant

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1711



-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE three MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on Feb 4, 2003
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-13 is/are pending in the application.
- 4a) Of the above, claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1, 2, and 4-13 is/are rejected.
- 7) ☒ Claim(s) 3 is/are objected to.
- 8) ☐ Claims _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- *See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

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1. Claim 12 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 12 provides for the use of a polyisocyanate, but, since the claim does not set forth any steps involved in the method/process, it is unclear what method/process applicant is intending to encompass. A claim is indefinite where it merely recites a use without any active, positive steps delimiting how this use is actually practiced.

Claim 12 is rejected under 35 U.S.C. 101 because the claimed recitation of a use, without setting forth any steps involved in the process, results in an improper definition of a process, i.e., results in a claim which is not a proper process claim under 35 U.S.C. 101. See for example *Ex parte Dunki*, 153 USPQ 678 (Bd. App. 1967) and *Clinical Products, Ltd. v. Brenner*, 255 F. Supp. 131, 149 USPQ 475 (D.D.C. 1966).

2. Claims 4-11 and 13 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Within claim 4, the species should be recited in the alternative.

Within claims 5 and 7, the language, "from among", is improper Markush terminology. A Markush group, by definition, is closed to the inclusion of other components; however, the use of "among" suggests that the group contains other unnamed species.

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Within claim 5, it is unclear what constitutes "oligoisocyanates". The use of the prefix, "oligo-", is not comparable to the use of the prefix, "poly-", within polyisocyanates.

Within claims 5 and 8, it is unclear what compounds are encompassed by the claimed "higher homologues".

Within claims 5 and 9, the multiple occurrences of "and" and "or" within the listing of the species are confusing; all species should be referred to in the alternative.

Within claim 6, the use of "preferably" and the language denoted by "preferably" renders the claim indefinite, because it is unclear if or to what extent the language further limits the less preferred language.

Within claim 8, it is unclear what constitutes a "hexamethylene diisocyanate oligomer mixture".

Within claim 9, it is unclear what constitutes "higher alkoxylation products".

Within claims 10 and 11, the use of "can be" renders the claims indefinite, because it is unclear if or to what extent the language denoted by "can be" is an optional limitation.

Within claim 13, the word, "obtainable", renders the claims indefinite, because it is unclear if the product is required to be derived from the reaction of the high-functionality polyisocyanate.

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

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(e) the invention was described in-

(1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or

(2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

4. Claims 1, 2, and 4-13 are rejected under 35 U.S.C. 102(b or e) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Bauriedel ('709) or Bolte et al. ('164).

Patentees disclose methods for producing polyurethane prepolymers, wherein the methods encompass reacting a diisocyanate having isocyanate groups with differing reactivities with a polyol, including triols, to yield a product having both isocyanate functionality and isocyanate reactive functionality, including single hydroxyl functionality, which is then reacted with another

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diisocyanate. Despite, applicants' arguments of February 4, 2003, patentees disclose preferred ratios of initial hydroxyl groups to initial isocyanate groups which will yield applicants' claimed addition product (A). See abstract and columns 2-5, especially column 5, line 4 within Bauriedel. See abstract and columns 2-4, especially, column 4, lines 21 and 22 within Bolte et al. The position is taken that when the disclosed trifunctional or higher polyols are used at the disclosed ratios, the disclosed processes anticipate applicants' process and high-functionality polyisocyanate.


5. However, if it is determined that the references fail to be anticipatory due to the fact that diols are also disclosed, the position is taken that it would have been obvious to one seeking increased functionality isocyanates to utilize the disclosed increased functionality polyols, while operating within the disclosed preferred index ratio range.

6. The examiner has considered applicants' response of February 4, 2003; however, the response is deficient for the following reasons. Firstly, despite applicants' arguments, the disclosed processes encompass scenarios where only a single hydroxyl group remains after step one. Secondly, contrary to applicants' argument at page 8 of the response, the instant process not only allows for the use of diisocyanates, the process claims them. Lastly, applicants' statement with respect to the properties that would be obtained by incorporating a polyisocyanate within the teachings of Bauriedel are not seen to be relevant to the issues at hand, because applicants' claims are not so limited. Furthermore, applicants have not provided evidence to support their position.

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7. Claim 3 is objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Any inquiry concerning this communication should be directed to R. Sergent at telephone number (703) 308-2982.


RABON SERGENT
PRIMARY EXAMINER

R. Sergent

April 14, 2003